



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,449	01/30/2001	Rai Abhyanker	10005056-1	3452

7590 03/01/2007
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

GREENE, DANIEL LAWSON

ART UNIT	PAPER NUMBER
----------	--------------

3694

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/774,449	Applicant(s) ABHYANKER ET AL.	
	Examiner Daniel L. Greene Jr.	Art Unit 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,9-14 and 17-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,9-14 and 17-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-7, 9-14 and 17-22 are pending. Claims 1, 2, 3, 5, 6, 9, 10, 11, 13, 14, 17, 21 and 22 are currently amended. An action on the merits of claims 1-7, 9-14 and 17-22 follows.

Response to Amendment

2. Applicant's response received 12/06/2006 has been fully considered and the following Objections and Rejections have been overcome.

a. Section 3 of the previous Office action as set forth on page 2 regarding the 35 U.S.C. 112 Rejections surrounding claims 5, 6, 14, 21 and 22.

b. Section 4 of the previous Office action as set forth on page 2 regarding the Objection to claims 2, 3, 10 and 11.

Accordingly, said Rejections and Objections are hereby withdrawn.

Response to Arguments

3. Applicant's arguments filed 12/06/2006, regarding the 35 U.S.C. 103(a) rejections of sections 8+ have been fully considered but they are not persuasive.

4. Applicant's arguments are unpersuasive as applicant has not shown that the references do not teach what the examiner has stated they teach, nor has applicant shown that the examiner's reasoning for and manner of combining the teachings of the references is improper or invalid.

5. **On page 9 of Applicant's arguments filed 12/06/2006, Applicant argues**

Art Unit: 3694

"The independent claims recite numerous recitations that are not taught or suggested in Maxwell. By way of example, independent claims 1, 9, and 17 recite receiving a set of financial applications at an internet exchange portal. "

RESPONSE: It appears applicant is arguing that Maxwell does not recite receiving information at an internet exchange portal. Maxwell is indeed directed towards the internet and information distributed therein. See for example the abstract. For arguments sake, even if Maxwell did not specify an internet exchange portal was where the receiving and generating was taking place, the limitation "at the internet exchange portal" does not define over the art of record as there is no patentability in merely changing where the functions are performed as long as the same result is accomplished. See, In re Dulberg, 129 USPQ 348, (CCPA 1961), "It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art"

It should be pointed out that Applicant's inventive concept is directed towards financing applications, however applications are nothing more than "forms" or a form. It is considered that the two nouns "application" and "form" are interchangeable and the limitation "financing" is non-functional descriptive matter in that a form is a form, no matter whether it's used for finances or any other business area.

Applicant continues to argue:

"These claims then recite "generating a genetic financing application from the set of applications." Maxwell does not teach or suggest these recitations. The Office Action cites Maxwell at column 8, lines 13-26 for allegedly teaching these recitations. Applicants respectfully disagree.

Column 8, lines 13-26 in Maxwell teaches how a user enters data into a data collection form. As note in the overview of Maxwell, a user is initially presented with a data collection form (9:50-51). The user enters data into this form, and the data is stored in a storage medium (9: 52-53). This data is used to populate other forms that the user encounters over the internet (9: 54-56). Nowhere does Maxwell teach or suggest "generating a genetic financing application from the set of applications." First, Maxwell stores the data in a storage medium. Maxwell never states or suggests that the data generates a "generic application." Again, Maxwell stores this data and creates icons (see 11: 1-23). Storing data and creating icons is not "generating a generic application." Second, the claims recite that the generic application is generated from a set of applications. In other words, a "set of applications" generates the generic application. By complete contrast, Maxwell never uses a set of applications to generate another application. Maxwell uses data entered into a data collection form to create icons. These icons are used to populate subsequent forms that a user encounters on the internet. Where is the set of applications in Maxwell that generates another application? They do not exist. Again, nowhere does Maxwell teach or even suggest whatsoever that a set of applications is used to generate a generic application."

RESPONSE: It is considered that Maxwell teaches "receiving a set of financing applications" and "generating a generic financing application from the set of applications" for at least the following reasons. Maxwell can be considered as receiving each, every and all applications or forms of whatever type and generating a generic application to fulfill the data population of and for each application, form, etc. That is, Maxwell is considered as the master data field populator of any information required by any form. Applicant is again directed to column 7, lines 40-63 and column 8, lines 13-55 wherein it is taught that in order to fill in a form, data must be first be entered into the database. The specific type of data that must be entered would of course be determined by the form or application that is to be filled out. Further, Maxwell discloses searching for

Art Unit: 3694

templates to aid in the population of data. This is also considered as receiving an application or form.

Applicant argues; "Where is the set of applications in Maxwell that generates another application?" This could also be rewritten as "Where is the set of forms in Maxwell that generates another form?"

RESPONSE: The "set of applications" in Maxwell can be considered as reading on the "templates that resemble the form image". In order to fill out any form, the data must have first been entered into the system. Again, Maxwell is the master form filler outter in that it can fill out any form by finding similar forms and comparing data fields for appropriate data.

It appears applicant is attempting to take a literal translation of Maxwell and not applying the teachings of what Maxwell's inventive concept truly embodies. Applicant is requested to not only consider what the Examiner has attempted to explain and expound upon, but also as to what Maxwell teaches on a bigger scheme, i.e. to fill out a form, no matter what kind of form it is.

See *In re Shepard*, 138 USPQ 148 (CCPA 1963)

"In considering disclosure of reference patent, it is pertinent to point out not only specific teachings of patent but also the reasonable inferences which one skilled in the art would logically draw therefrom."

Applicants claims are open ended, that is, they are merely "comprising the steps of". In this regard, there is no specific manner in which the steps must be performed, NOR is there an exclusion to other steps that may be performed either before or after the steps listed in the claims. Accordingly it is considered

Art Unit: 3694

that Maxwell discloses each and every limitation of the claims as set forth in the previous Office action.

6. **Regarding applicants challenge to Official Notice**, Resort may be had to any one of the following references as support that the previous Examiners Official notice is grounded in verifiable truth, that is, that it is known to consolidate data fields into a generic data field, and that this phenomenon is known as "merging";

Abelow "With a compatible database(s) and analysis software, any of those may be able to receive one or more data files to run their own analyses, which may include merging the received data with data from other sources to generate comparison reports, trend reports, forecasts, simulations, recommendations, etc. "

Steele et al. "[0094] The ATS 1002 merges the personal request for offer information 1014 and personal third-party information 1018 into a personal information record 1022. The personal information record 1022 includes the same Unique Identification Number (UIN) 1031 as the ATP 1024."

Schweitzer et al. "(10) Real-time, policy-based filtering, aggregation, enhancement and merging creates accurate, detailed and comprehensive session detail records (DRs). "

Jacobsen et al. Col. 4, lines 30-45

Thompson, III. "[0032] The software may include a number of standardized forms to use with the action plans, and certain actions to be initiated by the software may consist of taking one such standard form, merging data from a user's database regarding the user, a client, the situation, etc, and then automatically producing the desired document, whether it is an e-mail message or other electronic communication, a script for a conversation, a text message, a printed document or another type of document."

7. **Examiner's Note:** The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant.

Art Unit: 3694

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. **Claims 1, 2, 9, 10, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,589,290) Maxwell et al. for the reasons set forth in section 8 (page 3) of the previous office action mailed 4/6/2006 as expounded upon in section 5 above.**

10. Claims 3-6, 11-14, and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,589,290) Maxwell et al, hereafter Maxwell in view of (US 6,208,979) Sinclair for the reasons set forth in section 8 (page 4) of the previous office action mailed 4/6/2006.

It should be noted that the previous Office action contains a minor typographical error in that there are two sections 8, one on page 3 and one on page 4.

Applicant did not argue this specific rejection in the response received 12/6/2006 as the base reference (Maxwell) was argued in relation to the first section 8 of said Office action. Since applicant's arguments regarding Maxwell have already been addressed elsewhere within the instant Office action, no further explanation appears pertinent.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lebda et al. is "LendingTree.com" wherein it is set forth that a person only has to answer (i.e. fill in) **one set of questions** (financing application) **to receive responses from multiple lenders.** It is respectfully requested that Applicant peruse the Lebda et al. Patents and LendingTree.com Website while formulating a response to the instant Office action. Although no rejection is set forth herein,

Art Unit: 3694

as it is considered that the art already of record reads on applicant's inventive concept, it appears that an additional rejection based upon Lebda would be appropriate upon further prosecution.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

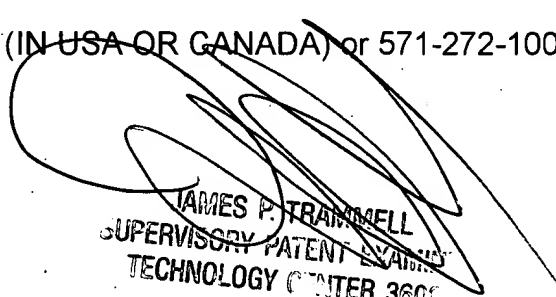
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene Jr. whose telephone number is (571) 272-6876. The examiner can normally be reached on Mon-Fri 8:30am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3694

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DIG 
2007-02-18


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3601